

U.S. Patent Appl. No. 09/800,330
RCE Dated May 05, 2005
Reply to Office Action of January 05, 2005
Docket No. 6169-143

IBM Docket No. BOC9-1999-0090

REMARKS/ARGUMENTS

These remarks are submitted responsive to the final office action dated January 05, 2005 (Office Action) as well as to the Advisory Action dated April 08, 2005. This response is filed after the 3-month shortened statutory period, and as such, a retroactive extension of time is herein requested. The Examiner is authorized to charge the appropriate extension fee to Deposit Account 50-0951.

In paragraph 12 of the Office Action, claims 1-5, 8-25, and 28-32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Published Application No. 2001/0042083 to Saito, *et al.* (Saito) in view of U.S. Published Application No. 2002/0054090 to Silva, *et al.* (Silva). In paragraph 13 of the Office Action, claims 6-7 and 26-27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Saito in view of Silva, in further view of U.S. Patent No. 6,732,102 to Khandekar (Khandekar).

In filing the Request for Continued Examination (RCE), Applicants have amended claims 1, 3, 4, 8-11, 22-24, and 28-31. Claims 1 and 22 have been amended to include limitations previously in claims 3 and 23, which are supported by page 20, lines 11-21. Claims 3 and 23 have been amended in a fashion supported by page 20, lines 14-16. Claims 4 and 24 have been amended in a fashion supported by page 25, lines 7-10. Claims 8-11 and 28-31 have been adjusted to limit the elements in the Markush and to alter claim dependencies, in a manner fully supported by the Applicants specification. No new matter has been added.

In the Advisory Action, Applicants' support overcoming the objections to the Declaration under 37 C.F.R. § 1.131 (the Declaration) and factual evidence relating thereto were not entered into the record and arguments based upon the same were not considered. These argument are now reasserted in this RCE.

In response, Applicants re-assert the previously submitted Declarations supporting the removal of Silva as a reference. The Declarations are accompanied by a copy of the

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Applicants' Confidential Invention Disclosure No. BOC8-1999-0119 (the "Disclosure") entitled "Method and Apparatus to Parse Generic HTML Data for Voice Presentation and User Interaction." The Disclosure demonstrate proof of conception for the claimed subject matter of the Applicants' invention at least as early as November 11, 1999, which predates the effective date of Silva of September 1, 2000.

As to conception, Applicants are required to provide (from MPEP 715) facts showing a completion of the invention commensurate with the extent of the invention as claimed. In proving conception, Applicants can show that the differences between the claimed invention and the showing under 37 CFR § 1.131 would have been obvious to one of ordinary skill in the art. Such evidence is sufficient because Applicant's possession of what is shown carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art. Facts to be used in support of a 37 CFR § 1.131 Declaration (from MPEP 715.07) can include supporting statements by witnesses (MPEP 715.07 (G)) and disclosure documents (MPEP 715.07(H)).

The Disclosure is the completion of an IBM confidential disclosure form, which is a standardized document utilized by the International Business Machines Corporation (IBM) and submitted by the inventors upon conception of an invention. The document management system under which the IBM confidential disclosure form has been generated does not permit amendments to be made to the Disclosure, once the Disclosure has been completed. Any changes and/or additions are appended to an attachment to the IBM confidential disclosure form along with the date the attachment was added. No such attachment accompanies the Disclosure, signifying that the Disclosure has not been amended since November 11, 1999.

The IBM confidential disclosure form provides all information necessary for outside legal counsel to prepare an appropriate patent application relative to the disclosed

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invention when used in conjunction with information known by one of skill in the art. The present Application, including each claim within the present Application, has been prepared based upon the Disclosure. Further, as noted in the enclosed Declarations, prior to submission of the application to the United States Patent and Trademark Office (USPTO), the inventors reviewed the Application to insure that the claims and material contained therein were fully supported by the Disclosure. The above facts are certified to be true to the knowledge of the undersigned and have been sworn to by the inventors in paragraphs 2-5 of the submitted Declarations.

Additionally, in the Application claims are fully supported by the Disclosure that includes:

"The solution uses a table lookup mechanism that has contained within it, the structure of web pages being referenced. For example, the Yahoo movie pages have the theater name at byte offset 57 for 35 bytes, and repeating fields for the movies playing at by 235 for 600 bytes (for example). So rather than parsing the page to "flip" one set of tags to another and keep the data in place and in a coupled together interface, there would be a table lookup for the page layout (like a Lotus Notes template) and the data can be extracted and placed into Voice (or other) oriented markup specific to the application."

An inventive aspect of the Disclosure readily apparent to one of ordinary skill in the art pertains to automatically extracting data from a Web page encoded in one format (the data can be extracted from the in-place data within the Web site) for presentation in a targeted medium or interface in another format ("and placed into oriented markup specific to the application"). Accordingly, the Applicants have claimed (claim 1) a method for converting formatted content comprising identifying a template which corresponds to a specified document and a target markup language, said specified document including said formatted content that is formatted using a markup language; applying said template to said specified document, an application extracting data from said formatted content; and

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formatting said data based upon the template; wherein formatting produces a second document formatted for the target markup language. This claimed method, as well as all other claims within the present application, fall within the scope of the Disclosure for purposes of conception (i.e. Applicants' possession of what is shown *in the Disclosure* carries with it possession of variations and adaptations, which would have been obvious, at the same time, to one of ordinary skill in the art.)

Applicants further exercised due diligence from prior to the effective date of Silva to March 6, 2001, the filing date of the instant application. In regard to diligence, as set forth in the Declarations, once an IBM invention disclosure form is completed, the disclosure is reviewed by an invention review board within IBM to determine whether to prepare an application based upon the submitted disclosure. Upon reaching a decision to prepare an application, outside counsel is selected to prepare the application, and instructions in this regard, together with the IBM invention disclosure form, are conveyed to the outside counsel. The outside counsel prepares a draft of the Application that is iteratively reviewed by each inventor until such time that the inventors are satisfied that the Application sufficiently details the inventive concepts detailed in the Disclosure, at which time the Application is expeditiously filed with the USPTO. The above facts are certified to be true to the knowledge of the undersigned and have been sworn by the inventors in paragraphs 2-5 of the submitted Declarations.

As to the period between September 01, 2000 and March 06, 2001, this was a time period in which outside counsel spent drafting the present application and iteratively reviewing and revising the drafted application with the inventors until it was finalized in its submitted form. This activity (*reasonable time spent drafting and reviewing a patent application*) is believed to fall within the legal requirements for a showing of diligence under MPEP 715.07(a). As to proof of this activity, Applicants refer the Examiner to the following documents:

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1. May 11, 2000 document entitled "6169-143 Misc" evidencing attorney notes taken during telephone conference with inventors regarding invention;
2. November 15, 2000 letter to inventor concerning the first submitted draft of the present application for inventor review;
3. February 1, 2001 fax transmission page indicating correspondence between the patent attorney and the lead inventor regarding the draft application;
4. February 15, 2001 fax transmittal page indicating correspondence between the patent attorney and the lead inventor (forwarding a revised draft with formal documents for signing);
5. February 22, 2001 letter to an inventor for review of the application and signing of formal documents;
6. February 27, 2001 letter to an inventor for review of the application and signing of formal documents; and
7. Paragraphs 4 and 5 of the sworn and notarized declarations provided by the inventors.

In light of the above, Applicants have shown that the present invention was conceived before the effective date of Silva and that legally sufficient diligence was exercised in constructively reducing the invention to practice at least in regard to the critical time period between just prior to the effective date of Silva until the filing date was exercised. Accordingly, Silva should be withdrawn as a reference for purposes of 35 U.S.C. § 103(a), which action is respectfully requested. Withdrawal of Silva as a reference should result in a withdrawal of the rejections with respect to claims 1-32, which action is respectfully requested.

Applicants believe that this application is now in full condition for allowance, which action is respectfully requested. The Applicants request that the Examiner call the

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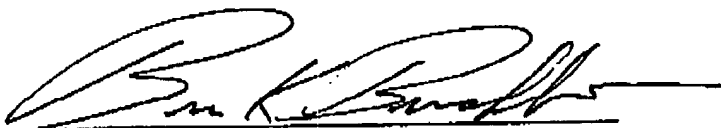
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undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

Date:

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Gregory A. Nelson, Registration No. 30,577
Brian K. Buchheit, Registration No. 52,667
AKERMAN SENTERFITT
Customer No. 40987
Post Office Box 3188
West Palm Beach, FL 33402-3188
Telephone: (561) 653-5000